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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,723	12/06/2001	Christopher John Gilham	3036/50649	2656

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CROWELL & MORING LLP  
Intellectual Property Group  
P.O. Box 14300  
Washington, DC 20044-4300

EXAMINER

CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/003,723

Applicant(s)

GILHAM &amp; ATKINSON

Examiner

WILLIAM D CUMMING

Art Unit

2683

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10,12-17,19-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10,12-17,19-21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of wirelessly transmitting location dependent data and receiving the location dependent data in a mobile telephone which is in a standby mode as stated by claim 1; the step of the sensor provides information relating to environmental conditions as stated by claim 5; the mobile telephone which carried by a passing user and carried in a vehicle as stated by claim 8; the step of storing collected data in a memory as stated by claim 23 must be shown or the features canceled from the claims. No new matter should be entered.
2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The new drawings are objected to under 37 CFR 1.83(a) because they fail to show the boxes labeled as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP, § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### 4. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

##### Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

##### Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, is required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

##### Timing of Corrections

Applicants are required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-10, 12-17, 19-21, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describes and /or fail to originally support the now claimed the step of wirelessly transmitting location dependent data and receiving the location dependent data in a mobile telephone which is in a standby mode as stated by claim 1; the step of the sensor provides information relating to environmental conditions as stated by claim 5; the mobile telephone which carried by a passing user and carried in a vehicle as stated by claim 8; the step of storing collected data in a memory as stated by claim 23. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicants must also convey, with reasonable clarity to those skilled in the art, that applicants, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*"

requirement of 35 USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-10, 12-17, 19-21, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "*the collected data*" lacks antecedent basis in claim 1.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-4, 7-10 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alewine, et al** in view of **Tsukamoto, et al**.

**Alewine, et al** disclose all subject matter, note paragraph 3 of the Office action dated May 19, 2004, except for receiving the location dependent data in a mobile telephone which is a standby mode and a mobile telephone is carried by a user. The examiner takes Official notice that for receiving the location dependent data in a mobile telephone which is a standby mode and a mobile telephone is carried by a user is old and well known in the art. Applicants even state this as prior art on page 1 of there specification since if a mobile telephone is registered in a standby mode to a base station the mobile station must receive location dependent data to remain register to such a base station. Regarding a mobile telephone is carried by a user, this has been done by, maybe by billions of people, since it was portable mobile telephones was being commercially

available since the 1970's. Also the examiner submits **Tsukamoto, et al** as evidence that for receiving the location dependent data in a mobile telephone which is a standby mode and a mobile telephone is carried by a user was well known for at least fifteen years and clearly not invented by applicants. Hence, it would have been very obvious at the time the claimed invention was made to one below ordinary skill in the art to incorporate the very old and admitted prior art of for receiving the location dependent data in a mobile telephone which is a standby mode and a mobile telephone is carried by a user in the method of collecting location dependent data of **Alwine, et al** in order for the system to keep track of the mobile telephone as it goes cell to cell and for the user, the well known convenience of having a mobile telephone which can be taken out of the car.

13. Claims 5-6 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alewine, et al** in view of **Tsukamoto, et al** as applied to the claims above, and further in view of **Grube, et al** as for the same reason as stated in paragraph 5 of the Office action dated May 19, 2004.

14. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alewine, et al** in view of **Tsukamoto, et al** as applied to the claims above, and further in view of **Tracy, et al** as for the same reason as stated in paragraph 6 of the Office action dated May 19, 2004.



***Response to Amendment***

**15. Elimination of Post Office Box in Arlington, Virginia for Patent Related Correspondence**

Effective immediately, the Office will cease accepting patent-related correspondence addressed to the P.O. Box 2327 Arlington, VA 22202. Effective May 1, 2003, pursuant to 37 CFR 1.1, patent-related correspondence should have been addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Accordingly, as of May 1, 2003, the provisions of 37 CFR 1.8 (Certificate of Mailing) and 1.10 (Express Mail certificate) that were waived by the Office were no longer waived for correspondence addressed to P.O. Box 2327, Arlington, VA 22202.

In November of 2001, the Office established a Post Office Box in Arlington, Virginia (P.O. Box 2327, Arlington, VA 22202) for use on an emergency basis, and indicated that the Office would continue to accept patent-related correspondence at this Arlington, Virginia Post Office Box and treat such correspondence as if it were addressed as set forth in 37 CFR 1.1 for purposes of 37 CFR 1.8 and 1.10 until further notice. On March 25, 2003, the Office provided notice that persons submitting correspondence to the Office should no longer use the Arlington, Virginia Post Office Box for any correspondence (including sequence listings in electronic format) after May 1, 2003. See Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

Correspondence in patent-related matters to organizations reporting to the Commissioner for Patents must be addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Appropriate mail stops should also be used. See the notice titled "Special Mail Stops For Patent Mail" that is published each week in the Official Gazette Notices and posted on the USPTO Internet web site.

Questions regarding this notice may be e-mailed to PatentPractice@uspto.gov, or directed to the Inventors' Assistance Center (formerly the Patent Assistance Center (PAC)) by telephone at 800-786-9199 or 703-308-4357. **OG Notices: 29 June 2004**

16. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

17. If applicants request an interview after this **final rejection**, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to **restate arguments** of record or to **discuss new limitations** which would require more than nominal reconsideration or new search will be denied.

## **18. Patent Application Publications May Now Include Amendments**

As a consequence of the use of Image File Wrappers (IFW), the United States Patent and Trademark Office (Office) has begun to publish patent applications with amendments that expedite the publication process. For example, the patent application publication may be based upon amendments to the specification that are reflected in a substitute specification, an amendment to the abstract, amendments to the claims that are reflected in a complete claim listing, and amendments to the drawings that are reflected in replacement drawing sheets, provided that such substitute specification or amendment is submitted in

sufficient time to be entered into the application file wrapper before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin between fourteen and nine weeks prior to the projected date of publication (the projected publication date is indicated on the filing receipt for the patent application). Accordingly, the provisions 37 CFR 1.215(a) are waived to the extent that they are inconsistent with this change in practice. 37 CFR 1.215(a) will be revised consistent with this change in practice, when the rule changes proposed in Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 68 Fed. Reg. 53816 (Sept. 12, 2003), 1275 Off. Gaz. Pat. Office Notices 23 (Oct 7, 2003) are made final.

Although the Office has begun to include amendments in patent application publications, applicants desiring to ensure that a patent application publication reflects an amendment should submit the application, as amended, through the Electronic Filing System (EFS). See 37 CFR 1.215(c). See also Helpful Hints Regarding Publication of Patent Applications, 1249 Off. Gaz. Pat. Office Notices 83 (August 21, 2001). In addition, if the application is not maintained in an IFW, and the amended application is not submitted through EFS, a petition under 37 CFR 1.182 will continue to be necessary for certain drawings to be included in the patent application publication. See Manual of Patent Examining Procedure, Section 507 (8th ed. 2001, rev. 1, Feb. 2003).

General questions regarding publication of patent applications should be directed to the Customer Service Center, Office of Patent Publication, by telephone at (703) 305-8283. Questions regarding the Electronic Filing System should be directed to (703) 305-3028. Questions of a legal nature should be directed to the Office of Patent Legal Administration at (703) 308-6906. **OG Notices: 13 April 2004**

#### 19. Oversized Postcards Must Be Submitted With Sufficient Postage

Recently, a number of return receipt postcards have been returned to the U.S. Patent and Trademark Office (Office) because the postcards contained insufficient postage for an oversized postcard. Oversized postcards require First-Class letter postage. Customers are reminded that they are solely responsible for placing the proper postage on self-addressed postcards that are submitted to the Office for the purpose of obtaining a receipt for correspondence being filed in the Office.

Customers should be aware of the following guidance from the USPS regarding postage and acceptability for postcards:

1. In order to be eligible for the First-Class Mail card rates (currently \$0.23 per card, domestic delivery), cards must be of uniform thickness and made of unfolded and uncreased paper or card stock of approximately the quality and weight of a Postal Service stamped card. Cards claimed at the First-Class postcard rate must be:

(a) Rectangular;

(b) No less than 3-1/2 inches high, 5 inches long, and 0.007 inch thick; and

(c) No more than 4-1/4 inches high, 6 inches long, and 0.016 inch thick.

2. Cards that measure more than 4-1/4 inches high, 6 inches long, or 0.016 inch thick are charged postage at the First-Class Mail letter rates.

3. Cards that measure less than 3-1/2 inches high, 5 inches long, and 0.007 inch thick are nonmailable.

Any return receipt postcard that does not contain sufficient postage or is not acceptable may not be delivered by the United States Postal Service (USPS) to the address provided on the postcard, and, if returned to the Office, may be discarded.

For information regarding the Office's postcard receipt practice in patent-related matters, see Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003), Section 503. Questions regarding sufficient postage for postcards should be directed to the United States Postal Service. Questions regarding this notice may be e-mailed to [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov), or directed to the Inventors' Assistance Center by telephone at (800)786-9199, or (703)308-4357. **OG Notices: 29 June 2004**

**20. Relocation of Customer Service Windows for Patent-Related Correspondence;  
Establishment of Drop Box in South Tower for Certain Patent-Related Correspondence;**

**Hand Carry and Mailing Address for Trademark-Related Correspondence**

Effective January 14, 2005, a new Customer Service Window for patent-related correspondence will open at 8:30 a.m. at the USPTO Alexandria campus. The Customer Service Window (Lobby, Room 1B03) and the PCT Customer Service Window (8th floor) currently located at 220 20th Street South, Crystal Plaza Two, Arlington, VA 22202 will close at 12:00 midnight on January 13, 2005 and will be consolidated at the Alexandria campus.

**Customer Service Window for Patent-Related Correspondence** The location for the new Customer Service Window is on the first floor of the south side of the Randolph Building, with street level access from Ballenger Avenue. The specific hand carry or delivery address is: Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314 If the appropriate mail stop is known, the mail stop should also be included in the address. Documents for the Customer Service Window or the PCT Customer Service Window may be hand carried or delivered to the new Customer Service Window at the above Alexandria address on or after January 14, 2005. No application numbers will be assigned by window staff at the time of delivery. Hours of Operation will be 8:30 a.m. through 12 midnight, Monday through Friday, except holidays and if the USPTO is closed for inclement weather or an emergency.

**Drop Box in South Tower for Certain Patent-Related Correspondence** Additionally, a satellite drop location will be established in the lobby of the South Tower building in Crystal City (2900 Crystal Drive, Arlington, Virginia), effective January 14, 2005. This location will not be staffed but will be monitored by the building guard. Applications and application-related papers may be left at this location during the hours of 8:30 a.m. and 7:00 p.m., Monday through Friday, except holidays and if the USPTO is closed for inclement weather or an emergency. The guard will not allow materials to be left except during those hours. No postcard receipts will be stamped at time of drop off, nor will the guard answer any processing questions. Materials will be retrieved periodically throughout the day and taken to the appropriate location for processing.

**Other Information Regarding Patent-Related Correspondence** The new customer service window and new drop box must not be used for correspondence that is required to be mailed to post office boxes other than P.O. Box 1450, Alexandria, VA 22313-1450, filed by facsimile, filed electronically, or hand-delivered to a different address. PCT customer service offices will provide file inspection for files located in PCT PALM locations. The PCT file inspection location is Room 4A22, 2900 Crystal Drive, Arlington, Virginia (South Tower). Customers should call 703-305-3165 in advance to make arrangements to inspect a file. Requests to inspect files located in OIPE PALM locations should be directed to the File Information Unit (FIU) at 703-308-2733. The FIU is located in Room 2E04, 2900 Crystal Drive, Arlington, Virginia (South Tower). Patent-related correspondence sent through the United States Postal Service should continue

to be directed to the addresses set forth in 37 CFR 1.1 (revised effective September 13, 2004) (e.g., P.O. Box 1450, Alexandria, VA 22313-1450).

**Hand Delivery and Mailing Address for Trademark-Related Correspondence** Use of any patent boxes for trademark-related correspondence is strongly discouraged, and may result in delayed processing. Most trademark-related correspondence, including Madrid Protocol-related correspondence, may be filed electronically using the Trademark Electronic Application System (TEAS), at [www.uspto.gov](http://www.uspto.gov). The USPTO prefers that filers use TEAS where possible. Trademark-related correspondence also may be hand-delivered to the Trademark Assistance Center (TAC) located at:

Trademark Assistance Center  
James Madison Building - East Wing  
Concourse Level  
600 Dulany Street  
Alexandria, VA 22314

Hand deliveries of Madrid Protocol-related correspondence should also include the notation "Attention: MPU". Hours of operation for TAC are 8:30 a.m. - 5:00 p.m. Monday through Friday, except holidays or days the USPTO is closed for inclement weather or emergency. Trademark-related correspondence sent through the United States Postal Service, except documents sent to the Assignment Services Division for recordation, requests for copies of trademark documents, and documents filed under the Madrid Protocol, should be mailed to: Commissioner for Trademarks

P.O. Box 1451  
Alexandria, VA 22313-1451

Madrid Protocol-related documents sent through the United States Postal Service should be mailed to:

Commissioner for Trademarks  
P.O. Box 16471  
Arlington, VA 22215-1471  
Attn: MPU

Questions regarding this notice may be e-mailed to [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov), or directed to the Inventors' Assistance Center (formerly the Patent Assistance Center (PAC)) by telephone at (800)786-9199, or (703)308-4357.

***Response to Arguments***

21. Applicants' arguments with respect to claims 1-10, 12-17, 19-21, and 23 have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I'Anson, et al disclose a method of adapting a user interface to the user's current situation. The method involves a user specifying a home-area interface (83), for example, a web browser home page, and an "away" interface (84). When the user connects to a network (10) using a device (20) and calls up his/her browser home page, a determination is made of the location of the device in order to decide which version of the home page is to be served back to the user device by the home-page server of the user. In a preferred embodiment, the "away" home page (84) includes specific types of local data of interest to the user (such as best local restaurants). When asked to provide the "away" home page, the homepage server uses this information to find the URLs of local special interest web sites (122) carrying the relevant type of data, the server inserting these URLs in the "away" home page (84) before providing it to the user device (20) concerned.

23. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to **expire THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**25. Replacement Notice: Copies of Patent Application Records will be Provided in both Electronic and Paper Form**

The Official Gazette notice, published on August 24, 2004 entitled "*All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form*" (1285 Off. Gaz. Pat. Off, August 24, 2004) is hereby rescinded. The USPTO is reinstating, until further notice, the procedures in effect prior to July 30, 2004 for providing certified copies of patent application records with paper certification statements. The USPTO will also offer electronic certified copies of patent application records at the requester's option.

**Certified Copies with Paper Certification**

Unless otherwise requested, certified copies of patent application records provided pursuant to 37 CFR 1.19 (b) will be produced with a paper certification statement, continuing the practice in effect prior to July 30, 2004. The certification statement will include an embossed seal and original signature.



**Certified Copies with Electronic Certification**

Customers ordering certified copies of patent applications as filed or patent-related file wrapper and contents of published applications from the USPTO website will have the option to choose electronic copies with electronic certification. These files include an imaged certification statement as part of a PDF file containing the document TIFF images. These electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. Customers may choose to download these electronic files from the USPTO website or receive them on compact disc.

**Paris Convention for the Protection of Industrial Property and Priority**

Irrespective of whether the USPTO provides a paper certified copy or an electronic certified copy, Article 4(d)(3) of the Paris Convention prohibits any country that is a member of the convention from requiring further authentication of the certified copy for purposes of claiming priority under the Paris Convention. (The text of the Paris Convention and a list of its members are available at [www.wipo.int/treaties/en/ip/paris/index.html](http://www.wipo.int/treaties/en/ip/paris/index.html).)

The USPTO is working with other intellectual property offices to encourage the acceptance of priority documents in electronic form with electronic certification. A list of offices and international intellectual property organizations that have agreed to accept electronic certified copies will be posted on the USPTO website soon, and updated regularly.

Questions should be directed to the Office of Public Records by email to [opr@uspto.gov](mailto:opr@uspto.gov) or by telephone at (703) 308-9743.

**26. USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies****Summary**

In support of its 21st Century Strategic Plan goal of increased patent e-Government, beginning in June 2004, the United States Patent and Trademark Office (Office or USPTO) will begin the phase-in of its E-Patent Reference program and hence will: (1) provide downloading capability of the U.S. patents and U.S. patent application publications cited in Office actions via the E-Patent Reference feature of the Office's Patent Application Information Retrieval (PAIR) system; and (2) cease mailing paper copies of U.S. patents and U.S. patent application publications with office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty (PCT). In order to use

the new E-Patent Reference feature applicants must: (1) obtain a digital certificate and software from the Office; (2) obtain a customer number from the Office; and (3) properly associate patent applications with the customer number. Alternatively, copies of all U.S. patents and U.S. patent application publications can be accessed without a digital certificate from the USPTO web site, from the USPTO Office of Public Records, and from commercial sources. The Office will continue the practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of cited references will continue to be provided by the USPTO for international applications under the PCT during the international stage.

### Deployment of E-Patent Reference System

The USPTO will deploy the full E-Patent Reference program starting in June of 2004. In accordance with the schedule shown below, paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions in the indicated Technology Centers (TCs). Paper copies of foreign patents and non-patent literature will continue to be included with office actions.

#### Schedule

June 2004      TCs 1600, 1700, 2800 and 2900

July 2004      TCs 3600 and 3700

**August 2004      TCs 2100 and 2600**

### Description of E-Patent Reference System

On December 1, 2003, the Office made available a new feature in the Office's Private PAIR system, E-Patent Reference, to allow convenient downloading and printing of cited U.S. patents and U.S. patent application publications. A notice announcing this system was published in the Official Gazette, (see Notice of Office Plan to Cease Supplying Copies of Cited U.S. Patent References With Office Actions, and Pilot to Evaluate The Alternative of Providing Electronic Access to Such U.S. Patent References, 1277 Off. Gaz. Pat. Office 156 (Dec. 23, 2003)). The same notice also announced the Office's future plan to cease supplying copies of cited U.S. patents and patent application publications with Office actions.

The E-Patent Reference system allows an authorized user of Private PAIR to download the U.S. patents and U.S. patent application publications cited on a form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants as part of an information disclosure statement (IDS) on form PTO/SB/08 (1449). The retrieval of some or all of the documents is performed in one downloading step with each of the documents encoded as Adobe Portable Document format (.pdf) files.

The E-Patent Reference system was used by applicants during a pilot program in December 2003 and January 2004. In response to some technical issues discovered by users, changes to make the system more compatible with users' firewalls and office systems were made during the pilot.

Consequently, applicants should expect to start receiving Office actions (in patent applications and during patent reexamination proceedings) without paper copies of cited U.S. patents and U.S. patent application publications in accordance with the schedule above. These documents will be available through the E-Patent Reference system for downloading using Private PAIR. Foreign patents and non-patent literature will continue to be provided to the applicant on paper. Communications from the Office during the international stage of an international application under the PCT will continue to include paper copies of all references, including U.S. patents and U.S. patent application publications.

In summary, all U.S. patents and patent application publications are available on the USPTO web site, from the Office of Public Records and from commercial sources. Additionally, a simple system for downloading the cited U.S. patents and patent application publications has been established for applicants, called the E-Patent Reference system. As E-Patent Reference and Private PAIR require participating applicants to have a customer number, retrieval software and a digital certificate, all applicants are strongly encouraged to contact the Patent Electronic Business Center to acquire these items. To be ready to use this system by June 1, 2004, contact the Patent EBC as soon as possible.

#### Steps to Use the E-Patent Reference Feature

Access to Private PAIR is required to utilize E-Patent Reference. If you do not already have access to Private PAIR, the Office urges practitioners and applicants not represented by a

practitioner to: (1) obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate; (2) obtain a USPTO customer number; (3) associate all of their pending and new application filings with their customer number; (4) install free software (supplied by the Office) required to access Private PAIR and the E-Patent Reference; and (5) make appropriate arrangements for Internet access.

Instructions for performing the 5 steps:

Step 1: Full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

Step 2: To get a Customer Number, download and complete the Customer Number Request form, PTO-SB/125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Patent Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or agent, then your registration number must be associated with your customer number. This association is accomplished by adding your registration number to the Customer Number Request form.

Step 3: A description of associating a customer number with the correspondence address of an application is described at the EBC Web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

Step 4: The software for electronic filing is available for downloading at [www.uspto.gov/ebc](http://www.uspto.gov/ebc). Users can also contact the EFS Help Desk at (703) 305-3028 and request a copy of the software on compact disc. Users will also need Adobe Acrobat Reader, which is available through a link from the USPTO web site.

Step 5: Internet access will be required which applicants may obtain through a supplier of their own choice. As images of large documents must be downloaded, high-speed Internet access is recommended.

The E-Patent Reference feature is accessed using a button on the Private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over

the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents in the Portable Document Format (.pdf). The downloaded documents can be viewed and printed using Adobe's Acrobat Reader program and other software.

### Other Options

The E-Patent Reference function requires the applicant to use the secure Private PAIR system, which establishes confidential communications with the applicant. Applicants using this facility must receive a digital certificate, as described above. Other options for obtaining patents which do not require the digital certificate include the USPTO's free Patents on the Web program (<http://www.uspto.gov/patft/index.html>). The USPTO's Office of Public Records also supplies copies of patents and patent application publications for a fee (<http://ebiz1.uspto.gov/oems25p/index.html>). Commercial sources also provide patents and patent application publications.

Section 707.05(a) of the Manual of Patent Examining Procedure, which currently provides that copies of cited references are in general automatically furnished without charge to applicant together with the Office action in which they are cited, will be revised in due course for consistency with the practice announced in this notice.

### Comments

The Office published a notice announcing its plan to cease supplying copies of cited U.S. patent references with Office actions, (see Notice of Office Plan to Cease Supplying Copies of Cited U.S. Patent References With Office Actions, and Pilot to Evaluate The Alternative of Providing Electronic Access to Such U.S. Patent References, 1277 Off. Gaz. Pat. Office 156 (Dec. 23, 2003)). The Office received numerous comments in response to this notice. A summary of representative comments and the Office's responses to the comment, grouped by topics, follows:

Comment 1: The requirement to use the Office's customer number/digital certificate shifts the responsibility of producing paper copies to the applicant. A number of comments indicated

that adopting the proposal would result in an increased responsibility for the applicant, as the applicant or applicant's representative would be required to print the references.

Response: The USPTO is implementing the E-Patent Reference program as part of the Office's e-Government initiative and to align funding priorities to the Patent Initiatives, including the hiring of examiners. Applicants can purchase copies of U.S. patents and patent application publications from a variety of vendors if they choose not to print copies through the E-Patent Reference system.

The USPTO is moving toward electronic filing and processing of both patent applications and trademark applications. The policy announced in this notice is simply a step towards a more fully automated patent examination process. By analogy, briefs and court opinions that include case citations do not include paper copies of the cited cases. Rather, the cited cases are available via books or electronic databases. Similarly, the USPTO will no longer provide paper copies of U.S. patents and patent application publications since they are available electronically free of charge. Finally, this change will avoid duplication and waste since an applicant may not need to print out every page of a cited U.S. patent or patent application publication.

Comment 2: Adopting the proposal would hurt the solo practitioners and pro se applicants the most, which is unfair.

Response: The solo practitioners and pro se applicants have the same electronic access as the larger firms and corporations, available instantaneously over the Internet. If a solo practitioner or a pro se applicant chooses not to print copies of U.S. patents and patent applications publications through the USPTO Patents on the Web system or through the E-Patent Reference system, commercial sources that provide patents very quickly and inexpensively are available, and copies of U.S. patents and patent application publications are also available at the Patent and Trademark Depository Libraries (PTDLs). Additionally, the cost of patents if ordered from the USPTO Office of Public Records is very reasonable (\$3).

Comment 3: Some applicants indicated that the service is reliable and quick, and consistent with the electronic commerce initiatives in their law firms and businesses.

Response: As pointed out by some respondents, electronic copies of the references are very usable, available without mail delays, and capable of being sent to clients, other attorneys and experts by electronic means.

Comment 4: The statute 35 USC Sec. 132 requires the Office when sending a rejection to state the reasons "together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application".

Response: The requirement that an Office action contain "such information and references as may be useful in judging of the propriety of continuing the prosecution of his application" was added to the patent laws in the Patent Act of 1870. The circumstances surrounding this provision reveal that it requires that an Office action identify the prior inventions or patents that are relied upon in making a rejection, not that it requires that an Office action be accompanied by copies of the cited references. The USPTO did not even begin providing copies of cited references with Office actions until 1965, when 35 U.S.C. Sec. 41 was amended to authorize (but not require) the USPTO to provide copies of patents cited in Office actions without charge. See 35 U.S.C. Sec. 41(e) ("[t]he Director may provide any applicant issued a notice under [35 U.S.C. Sec. 132] with a copy of the specifications and drawings for all patents referred to in that notice without charge") (emphasis added). Nevertheless, the Office will provide access to U.S. patents and patent application publications, albeit not in paper form.

Comment 5: A number of users suggested that the Office provide paper references at an extra cost.

Response: The Office of Public Records does offer that service, at a reasonable cost, and it is available through a number of delivery channels. See 37 CFR 1.19 (a). Commercial services also provide U.S. reference documents, in person, by mail, and over the Internet.

Comment 6: Some comments indicated that the length of the pilot should have been expanded.

Response: E-Patent Reference system will continue through the end of May to allow applicants to become familiar with E-Patent Reference and to be sure all technical concerns are addressed.

### For Further Information Contact

Questions concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the Patent EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov). Questions about this notice may be directed to Jay Lucas, at [Jay.Lucas@uspto.gov](mailto:Jay.Lucas@uspto.gov) and Rob Clarke, at [Robert.Clarke@uspto.gov](mailto:Robert.Clarke@uspto.gov). **OG**  
**Notices: 18 May 2004**

## **27. Consolidated Appropriations Act, 2005 enacted on December 8, 2004**

H.R. 4818, the Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act) was signed by President George W. Bush and enacted into law on December 8, 2004. The Consolidated Appropriations Act revises certain patent application and maintenance fees; provides separate fees for a basic filing fee, a search fee, and an examination fee; and requires an additional fee for any patent application whose specification and drawings exceed 100 sheets of paper (application size fee). The new patent fees are now effective and will remain in effect during the remainder of fiscal year 2005 and during fiscal year 2006. The patent maintenance fee changes apply to any maintenance fee payment made on or after December 8, 2004, regardless of the filing or issue date of the patent for which the fee is submitted. The revised maintenance fees took effect on December 8, 2004. Thus, any maintenance fee paid at any time on (or after) December 8, 2004 is subject to the revised maintenance fee amounts set forth in the Consolidated Appropriations Act.

**Note: If you are paying via the USPTO's Internet Web site, there will likely be a delay in updating the maintenance-fee information on the USPTO's Office of Finance On-Line Shopping Web page. Therefore, if paying on-line, please refer to the updated fee schedule to ensure that you include the appropriate updated fee amount. Maintenance fees must be timely paid in the appropriate amount to avoid expiration of a patent.**

The new basic filing fee (or national fee), search fee, examination fee, and application size fee apply to national patent applications (other than provisional applications) filed on or after December 8, 2004, and to international patent applications in which the basic national fee is paid on or after December 8, 2004. The new provisional application filing fee applies to any provisional application filing fee paid on or after December 8, 2004. The filing fee (or national fee), search fee, and examination fee are due on filing. If the filing fee (or national fee) is paid on filing, but the search fee and/or examination fee is missing, the USPTO will issue a notice requiring that any missing search fee and examination fee (but no surcharge until further notice) be paid within a specified period of time in order to avoid abandonment. Thus, if at least the full basic filing fee under the Consolidated Appropriations Act is paid on or after December 8, 2004, the USPTO will issue a notice requiring any balance of the search fee and the examination fee (but no surcharge). The remaining patent application fee changes, including the excess claims fees, extension of time fees, and appeal fees, apply to any fee payment made on or after December 8, 2004, regardless of the filing date of the application for which the fee is submitted.

USPTO customers should monitor the USPTO's Internet Web site frequently for current patent fee information.

Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required.



28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday-Tuesday 10:30am to 8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wdc



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A handwritten signature in dark ink, appearing to read "William Cumming", written over a horizontal line.

**WILLIAM CUMMING  
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